

REMARKS

Claims 1-7 are pending in the present application. Claims 1-3 are rejected. Claim 3 is herein amended.

Applicants' Response to Claim Rejections under 35 U.S.C. §102

Claims 1 and 2 were rejected under 35 U.S.C. §102(b) as being anticipated by Matsumoto et al. (U.S. Patent No. 5,815,060).

It is the position of the Office Action that **Matsumoto** discloses the invention as claimed. **Matsumoto** discloses an inductance element 1 comprising a lead line 4 and a magnetic core 2, which is made of a wound-up thin strip 3. Figures 1-3 disclose an embodiment where the magnetic core 2 appears to be disposed directly on the lead line 4. Figure 4 discloses a plurality of inductance elements disposed in an epoxy resin 5 forming a package body. Although not discussed in the Office Action, it is noted that Figure 7 discloses the formation of the inductance element 1 by wrapping a thin strip 3 around a lead line 4 to form a magnetic core 2. **Matsumoto** does not explicitly disclose a clearance between the hollow part of the magnetic core 2 and the lead line 4. Instead, the magnetic core 2 appears to be disposed directly on the lead line 4.

The Office Action states that “**Matsumoto** et al. inherently discloses a clearance between the hollow part of the magnetic core and the lead.” According to MPEP § 2112:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (emphasis in original).

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In other words, in order to rely on the inherency argument, it must be shown that a clearance is necessarily present in **Matsumoto**.

In response, Applicants respectfully submit that **Matsumoto** does not necessarily disclose a clearance between the magnetic core 2 and the lead line 4. In fact, **Matsumoto** discloses the opposite: a magnetic core 2 “directly wound” on lead line 4. See Figure 7 and associated text. Because **Matsumoto** does not necessarily require a clearance between the magnetic core 2 and the lead line 4, Applicants respectfully submit that **Matsumoto** does not inherently disclose a clearance as recited by claim 1. Applicants therefore respectfully traverse the rejection. Favorable reconsideration is respectfully requested.

Applicants’ Response to Claim Rejections under 35 U.S.C. §103

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Matsumoto in view of Uchikoba (U.S. Patent No. 6,137,389).

It is the position of the Office Action that **Matsumoto** discloses the invention as claimed, with the exception of an external metal member (metal electrodes). The Office Action relies on **Uchikoba** to provide this teaching.

Uchikoba discloses an inductance element comprising a signal line conductor 2 disposed in a hollow part of core 1, with terminal conductors 3 and 4 disposed on the ends of the inductance element. **Uchikoba** contains no suggestion or disclosure of a clearance between the core 1 and the signal line conductor 2. It is further noted that **Matsumoto** contains no suggestion or disclosure of metal members acting as electrodes.

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In response, Applicants again respectfully submit that **Matsumoto** does not inherently disclose a clearance. Applicants herein amend claim 3 in order to recite such a clearance, similar to the recitations of claim 1. Therefore, the combination of references does not establish prima facie obviousness with regard to amended claim 3.

Furthermore, Applicants respectfully submit that there is no suggestion or motivation in the cited art to combine **Matsumoto** and **Uchikoba**. The Office Action has provided no evidence of such a motivation in the art to combine the references. For at least the above reasons, Applicants respectfully traverse the rejection. Favorable reconsideration is respectfully requested.

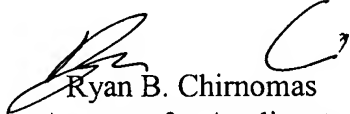
For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

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Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned agent.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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